

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

D. Remarks

Rejections Under 35 U.S.C. §112, Second Paragraph.

Claims 1, 10, 11, 12, 15 and 19 include the term “home page”. This term is believed to
5 be ubiquitous to those skilled in the art, both now and at the time the present invention was filed.
As evidence, Applicant points to the very art cited during the examination of this application.

The search engine, advertisements, browsing options, and gift registry options are show
10 in the **home page** or initial page of the on-line mall website. (*Wittsche*, Col. 10, Lines 37-
39, emphasis added).

If the customer selects step 810 the advertisement in FIG. 12A being displayed on the
15 **home page** website of the on-line mall, then the specific merchandise displayed in the
advertisement is displayed in step 836 in FIG. 12B. (*Wittsche*, Col. 10, Lines 61-65,
emphasis added).

In one embodiment, for example, a link to an order processing unit is provided on the
20 **home page** of a conventional search engine, such as Yahoo, Alta Vista, Lycos, or Excite.
(*Allsop et al.*, Col. 9, Lines 18-21, emphasis added).

The **home/main page** of the System Manager provides a quick summary of the current
system status; a screen capture of a typical main page in a preferred embodiment is seen
in FIG. 20. (*Ross, Jr. et al.*, Col. 17, Line 55-58, *emphasis added*).

25 Recognition of this term is also evidenced by the below citation:

Main Entry: **home page**

Function: *noun*

: the page typically encountered first at a World Wide Web site that usually contains
30 links to the other pages of the site or to other sites (Merriam-Webster Online Dictionary,
at <http://www.m-w.com>).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Accordingly, Applicant believes “home page” is well understood in the art, and not indefinite.

Claim 10 has been amended to address a second ground for rejection. The claim has been amended to eliminate the claims from being interpreted as including method steps of using an apparatus.

Rejection of Claims 1-3, 5-10, 12-13 and 15-19 Under 35 U.S.C. §103(a), based on Wittsche (U.S. Patent No. 6,556,975) in view of Cronin (U.S. Patent Publication No. US 2001/0032145 A1).

The rejection of claims 1-3 and 5-9 will first be addressed.

The invention of amended claim 1 is directed to a franchise system for organizing and establishing a headquarter for business transactions over a network. The franchise system includes various components including at least one headquarter network server, a plurality of franchise store servers, and a plurality of member servers.

The at least one headquarter network server has a number of elements including merchandise information memory data, a home page creation system, a home page sending service, an order receiving system, a received data transfer system, and a franchise store ID system.

As is well established, to establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.

Applicant traverses the present rejection based on a number of grounds.

A) The Combination of References Does Not Show All Limitations of Claim 1

1) No “home page creation system”

The cited combination of references is not believed to show or suggest “a home page creation system”.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant's amended claim 1 recites a home page creation system that creates a home page for each franchise store, the home page creation system

5 “accesses the merchandise information memory data for merchandise information to create a home page of each franchise store”, and

 “accesses a home page data memory system to collect additional home page data for the home page of each franchise store”.

10 Applicant does not believe the cited combination of references shows the above limitation.

 The rejection of Applicant's claims indicates a particular interpretation of the phrase “home page”.

15 For examination purposes the phrase “home page” will be treated as the main page of a website, which typically serves as an index or table of contents to other documents stored at the site and thereby is the first document the visitor/member views. (Office Action, dated 10/24/2005, Page 2, Last four lines).

20 While Applicant believes the term is not necessarily limited to such a reading (see the above comments related to the rejections under 35 U.S.C. §112, Second Paragraph), even under such a interpretation favorable to the rejection, the cited combination of references is still believed to not show or suggest Applicant's home page creation system, as recited above.

 To show a home page creation system, the rejection relies on the reference *Wittsche*.¹
25 However, *Wittsche* is directed to an on-line mall that presents a page for all stores in the mall. The reference never shows or suggests a server that provides a homepage for each individual store in the mall. All mentions of a “home page” set forth within *Wittsche* describe one homepage: that of the on-line mall, not any particular store within a community of the on-line mall:

30

¹ See the Office Action, dated 10/24/2005, Page 2, Lines 3-7.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The search engine, advertisements, browsing options, and gift registry options are shown in the home page or initial page *of the on-line mall website*. (*Wittsche*, Col. 10, Lines 37-49, emphasis added).

5 If the customer selects step 810 the advertisement in FIG. 12A being displayed on the home page website of the on-line mall, then the specific merchandise displayed in the advertisement is displayed in step 836 in FIG. 12B. (*Wittsche*, Col. 10, Lines 37-49, emphasis added).

10 If upon entry into the on-line mall home page the customer selects to enter the gift registry in step 814 in FIG. 12A, the gift registry page is displayed in step 837 in FIG. 12B. (*Wittsche*, Col. 11, Lines 10-11, emphasis added).

Thus, the discussion of home pages within the reference *Wittsche* are directed to a single home page for the entire on-line mall, and never to home pages for each store of the on-line mall.

Applicant concedes that *Wittsche* does provide one mention of store website pages:

20 The customer may then enter store 5 508 and purchase article 2. The customer purchases article 1 and article 2 from stores 1 504 and store 5 508, respectively. By selecting an item from a store's website page, the selected item is then placed in the customer's electronic "shopping cart. (*Wittsche*, Col. 5, Lines 40-44, describing FIG. 5, emphasis added).

However, this very limited discussion of a store website page is not the "first document the visitor/member views", nor does it "serve as an index or table of contents to other documents stored at the site".

The first document a visitor/member views is the mall home page noted above. *Wittsche* describes this arrangement:

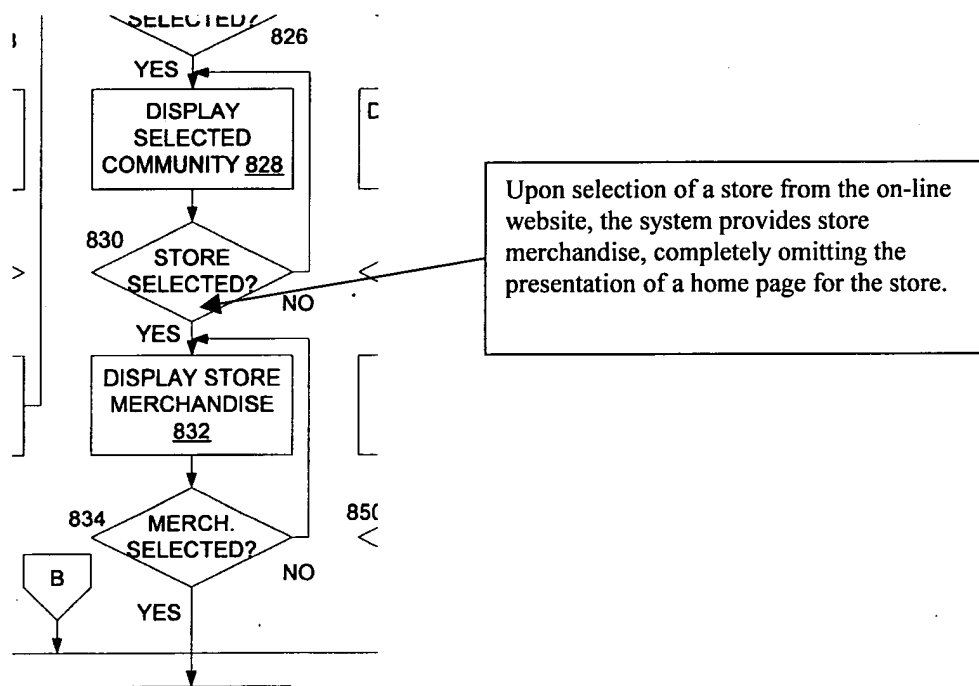
30 Referring now to FIG. 5... The customer contacts the on-line mall's computer 112 to obtain access to the on-line mall website. Once the on-line mall website is accessed, the customer selects the community the customer would like to enter. Once the customer has

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

entered a community, the customer has the ability to visit multiple stores... (*Wittsche* Col. 5, Lines 12-31).

The above would seem to indicate that a store's website page is a last page one would see at the on-line mall website. Further, the "store website page" of *Wittsche* is never described as an index or table of contents to other documents stored at the site. To contrary, only the mall home page is characterized as having such a feature.

Wittsche clearly supports Applicant's understanding of "store website pages". FIG. 12B of *Wittsche* shows operations of the on-line mall when a customer selects a store. As shown, below, upon selection of the store, the store merchandise is displayed not any home page for the store:



Therefore, because the cited reference only teaches the creation of a single home page for an on-line mall, the cited reference is not believed to show or suggest "a home page creation system that creates a home page for each franchise store" or a "home page sending service sends home page data for the home page of each franchise store to at least one predetermined member server", as recited in amended claim 1.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2) No “merchandise information memory data that includes... goods not available at one of the franchise stores but available at the headquarter”

5 The rejection reasoning for this limitation (previously present in claim 2), is set forth below:

10 The phrase... for good not available at one of the franchise stores, but available at the headquarter” The phrase(s) are given little patentable weight because the claim limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention... the non-functional descriptive material is directed only to the content of the data... and does not affect either the structure or method/process of Wittsche, which leaves the method and system unchanged (MPEP 2106). (Office Action, dated 10/24/2006, 15 Page 8, first full paragraph).

Applicant believes the above rationale is in error.

20 The above rejection rationale indicates that limitations of Applicant's claim have not been considered pursuant to MPEP §2106. However, this portion of the MPEP is not related to obviousness, but rather patentable subject matter – rejections based on an entirely different statute: 35 U.S.C. 101. If amended claim 1 is being rejected for not being patentable subject matter, the proper statute has not been cited, and Applicant has not been given a fair opportunity to address such a rejection, by either argument or amendment. Accordingly, no prima facie case of non-statutory subject matter has been established.

25 If the rejection is based on 35 U.S.C. 103(a), it is not proper as it does not address all claim limitations.

2143.03 All Claim Limitations Must Be Taught or Suggested

30 To establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." *In re Wilson*, 424

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (M.P.E.P. §2143.03, emphasis added).

5

Even indefinite limitations, or those not supported by the Specification, must be considered. Accordingly, Applicant believes the rejection failure to consider “goods not available at one of the franchise stores but available at the headquarter” is fatal to any prima facie case.

When considered, the above limitation adds to the patentability of claim 1. The
10 Specification notes the advantages of such an arrangement:

Moreover, each Franchise Store can supply many kinds of goods information, not only for its own stocked items, but also for other goods based on the huge scale of data at a Headquarters. (Applicant’s Amended Specification, paragraph [0029]).

15

Applicant adds that there is a clear functional interrelationship between this data and the operation of the system: such data is sent by a home page sending service.

a home page sending service that sends... information from the merchandise
20 information memory data... (Claim 1, Lines 19-21).

Further, the above is not believed to be obvious in light of the reference, either. As noted above, *Wittsche* teaches an on-line mall containing different retailers. There is nothing the reference to show or suggest that the system stores information for not available at a store but available at
25 some other location. In fact, *Wittsche* teaches the opposite:

The on-line mall store is viewed as a separate store of the overall merchant's store that may be available on a different website than the on-line mall. Thus, the *on-line store includes a subset of the merchandise available from the merchant*.
30 (*Wittsche*, Col. 8, Lines 30-34).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Clearly, the above would appear to expressly teach away from Applicant's amended claim 1, by presenting a restricted inventory (i.e., subset), as opposed to claim 1 which presents a larger set of goods than that available at a single franchise store.

Thus, because the rejection has improperly ignored Applicant's claim language, and the claim language recites limitations not shown or suggested, a prima facie case of obviousness is not believed to have been established exist.

B) No Motivation for the Proposed Modification of *Wittsche*

Applicant's invention, as recited in claim 1, is directed to a franchise system. That is, a system that combines a number of franchisors. As a result, the claim recites particular structures: franchise store servers and a franchise store ID system. The rejection acknowledges that the cited references do not show a franchise store arrangement, but gives no patentable weight to such limitations:

The rationale for not considering this claim limitation is set forth below

Wittsche discloses "communities" with associated stores but does not specifically disclose "franchise". In that regard and since the word "franchise" is not considered to be a limitation, which imparts any functional limitation to the claim and thereby is considered to be non-functional descriptive material (MPEP 2106 b). Therefore, "franchise" is not considered to provide patentable distinction. (Office Action, dated 10/24/2005, Page 4, Lines 16-20).

Just as the rejection has not considered the phrase "merchandise information memory data that includes... goods not available at one of the franchise stores but available at the headquarter", Applicant believes failure to consider "franchise" is also in error.

Applicant repeats that rejections based on subject matter (MPEP §2106) are not related to obviousness. Further, failure to consider all of Applicant's claim language results cannot result in a prima facie case of obviousness. As noted above in section A)2), "***All words in a claim must be considered*** in judging the patentability of that claim against the prior art."

Applicant adds that the franchise system of claim 1 is believed to be clearly not obvious in light of *Wittsche*. *Wittsche* arranges multiple stores into communities. Visitors access the on-

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

line mall, then access communities within the mall, where each community has a number of stores, as shown in FIG. 5 of the reference:

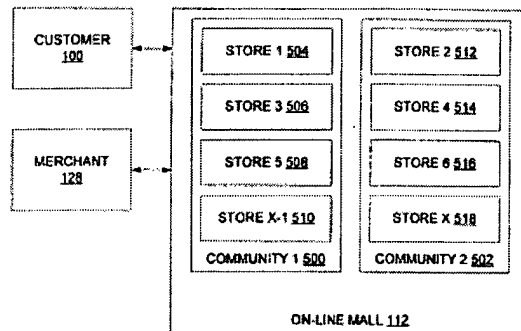


FIGURE 5

5 However, Applicant strongly believes that one would not want to create such a community with franchise stores. Applicant does not believe a visitor would find a mall with the same franchise repeated multiple times a desirable site, and *Wittsche* agrees. *Wittsche* describes malls that contain several different retailers:

10 Entrepreneurs, seeing this phenomenon, proposed that several retailers of both large and small size be contained within one large connected area so that customers could still visit their respective merchants to purchase the merchandise they desired... (*Wittsche*, Col. 1, Lines 17-22).

15 Accordingly, because the rejection has improperly ignored Applicant's claim language, and the claim language recites limitations not shown or suggested, a prima facie case of obviousness has not been established.

C) Dependent Claims 5 and 7-9 Separately Patentable

20 Various claims depending from claim 1 are believed to be separately patentable over the cited reference.

1) Claim 5 Separately Patentable

Claim 5 is believed to be separately patentable. Claim 5 recites that the "uniform

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

resource locator values include a first portion unique to each franchise store and a second portion common to all franchise stores and the headquarters”.

To show the limitations of claim 5, the rejection first relies on the following reasoning:

5 Regarding claim 5... Cronin teaches a franchise system, wherein the uniform resource locator value includes first portion unique to each store and a second portion common to all franchise stores and the headquarters (Para 0004 and Para 0014). (Office Action, dated 10/24/2005, Page 9, Second Full Paragraph).

10 Applicant respectfully disagrees with the above characterization of the reference. *Cronin* teaches web pages but they are unrelated to any store. A word search of the reference reveals that “store” or “stores” are never mentioned. Instead, the website of *Cronin* is aimed at providing web based marketing and/or management business information, not place to purchase goods.

The rejection of claim 5 includes the following additional rationale:

15 [P]lease note a URL specifies the... name of the server on which the resource resides (such as //www.whitehouse.gov), and, **optionally**, the path to a resource (such as an HTML document or a file on that server)... By definition, a URL... already includes what Applicant refers to as a “unique compound address” and a
20 “subaddress”, i.e., identifier(s)... For example in this case, the subaddress **could** have been the global address for the headquarter server. (Office Action, dated 10/24/2005, Page 9, Second Full Paragraph, bold emphasis added).

25 Applicant first notes that amended claim 1 is not directed to a single resource, but rather multiple franchise stores. Thus, the above rationale does not appear to show all of Applicant’s claim limitations.

Second, the above is not sufficient for prima facie case. Possible modifications (i.e., optionally, or could) are not sufficient for a prima facie case of obviousness.

30 The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

the combination.²

Accordingly, because the rejection does not appear to show all the limitations of claim 5, and/or provide sufficient motivation for the proposed modification, this claim is believed to be separately patentable over the cited reference.

2) Claims 7-9 Separately Patentable

Claims 7-9 are believed to be separately patentable for the same essential reason as claim 1. The limitations of claims 6-9 have not been considered in the obviousness rejection. Accordingly, a prima facie case of obviousness is not believed to have been established for these claims. If these claims are being rejected based on 35 U.S. C. 101, Applicant has not been afforded a fair opportunity to address such a rejection by either argument or amendment.

The rejection of claims 10 and 12-13 will now be addressed.

The invention of claim 10 is directed to an electronic franchise shopping system for a plurality of franchise stores. The system includes a plurality of franchise store servers and at least one headquarter network server. The at least one headquarter network server includes a goods master data base, a member entry data base, a franchise store data base, a home page data base, a home page creation system, a franchise store identification (ID) system, and an order system.

The rejection of claim 10 is traversed based on a number of reasons.

D) The Combination of References Does Not Show All Limitations of Claim 10

The cited combination of references is not believed to show or suggest all the limitations of claim 10. In particular, the references are not believed to show or suggest: (1) a goods master database or (2) a home page creation system.

1) No “goods master database”

Applicant’s claim 10 recites a goods master data base that stores information for goods

² In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

sold by the plurality of franchise stores, such goods including goods... not available at the particular franchise store but available at a headquarter.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section A)2) directed to claim 1. In particular, the rejection reasoning has not shown how such limitations are not present in the reference, and seems to impose a 35 USC 101 ground for rejection within a 35 USC 103 rejection.

2) No “home page creation system”

The home page creation system of claim 10 provides a home page for an accessing member according to unique web page data for the franchise store and goods information from the goods master data base. The home page is generated according to a predetermined data sent by the member from a remote user terminal.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section A)1). In particular, the reference *Wittsche* shows but one home page for an on-line mall, and not a home page with data unique to each store, as recited in claim 10.

E) No Motivation for the Proposed Modification of *Wittsche*

To the extent that the rejection of claim 10 relies on the modification of *Wittsche*, the comments of Section B) are incorporate herein.

F) Dependent claim 13 Separately Patentable

Claim 13 recites that url data sent includes a first portion corresponding to the franchise and a second portion unique to each franchise store.

To address this ground for rejection, Applicant incorporates by reference the same general comments set forth above in Section C)1) directed to claim 5.

The rejection of claims 15-18 will now be addressed.

The invention of claim 15 is directed to an electronic franchise shopping system for a plurality of franchise stores that includes a least one headquarter server and a plurality of

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

franchise servers, each corresponding to a different franchise store.

The at least one headquarter server has a number of elements including a goods master data base, a member entry data base, a franchise store data base, a home page data base, a franchise store ID system, a home page sending system, and an order processing system.

5

G) The Combination of References Does Not Show All Limitations of Claim 15

The cited combination of references does not show or suggest all the limitations of claim 1. In particular, the references do not show or suggest: a home page sending system.

10

No “home page sending service”

Applicant’s home page sending service of claim 15 sends home page data according to a first type universal resource locator (url) and a plurality of second type urls, the first type url comprising a url common to the system, each second type url corresponding to a different franchise store. The home page sending system also sends a home page for a franchise store based on member entry data base information, and sending a unique home page for each second type url. Each such unique home page including merchandise data for merchandise available at the franchise store, and merchandise not available at the franchise store but available at a headquarters location.

To address this ground of rejection, Applicant incorporates by reference the comments set forth above in Section C)2), with respect to the url arrangement of claim 15 and A)1) with respect to the home page sending arrangement of claim 1, and A)2) with respect to goods not available at each franchise store.

H) No Motivation for the Proposed Modification of *Wittsche*

To the extent that the rejection of claim 10 relies on the modification of *Wittsche*, the comments of Section B) are incorporate herein.

Rejection of Claims 4 and 11 Under 35 U.S.C. §103(a), based on *Wittsche* in view of *Cronin* and further in view of *Anuff et al.* (U.S. Patent No. 6,327,628).

The rejection of claim 4 will first be addressed.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Cronin*, the comments set forth above in Section A) are incorporated by reference herein.

The rejection of claim 11 will now be addressed.

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Cronin*, the comments set forth above in Section D) are incorporated by reference herein.

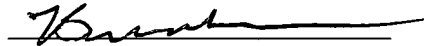
Rejection of Claim 14 Under 35 U.S.C. §103(a), based on *Wittsche* in view of *Cronin* and further in view of *Spagna et al.* (U.S. Patent No. 6,587,837).

To the extent that this ground for rejection relies on the combination of *Wittsche* in view of *Cronin*, the comments set forth above in Section D) are incorporated by reference herein.

Claims 1, 10 and 15 have been amended. Claims 2, 4-5 and 19 have been cancelled. Claim 10 has been amended to more clearly define the claim, and not in response to the cited art.

The present claims 1, 3, 6-18 are believed to be in allowable form. It is respectfully requested that the application be forwarded for allowance and issue.

Respectfully Submitted,



Bradley T. Sako
Attorney
Reg. No. 37,923

Bradley T. Sako
WALKER & SAKO, LLP
300 South First Street
Suite 235
San Jose, CA 95113
Tel. 1-408-289-5315